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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/822,743	04/13/2004	Sheng Chao Chen	MR1115-517	4602
4586	7590	02/24/2006	EXAMINER	
ROSENBERG, KLEIN & LEE 3458 ELLICOTT CENTER DRIVE-SUITE 101 ELLICOTT CITY, MD 21043			NEGRON, ISMAEL	
			ART UNIT	PAPER NUMBER
			2875	

DATE MAILED: 02/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/822,743	Applicant(s) CHEN, SHENG CHAO	
	Examiner Ismael Negron	Art Unit 2875	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☒ Claim(s) 1 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Abstract

Applicant is reminded of the proper content of an abstract of the disclosure.

A patent abstract is a concise statement of the technical disclosure of the patent and should include that which is new in the art to which the invention pertains. If the patent is of a basic nature, the entire technical disclosure may be new in the art, and the abstract should be directed to the entire disclosure. If the patent is in the nature of an improvement in an old apparatus, process, product, or composition, the abstract should include the technical disclosure of the improvement. In certain patents, particularly those for compounds and compositions, wherein the process for making and/or the use thereof are not obvious, the abstract should set forth a process for making and/or use thereof. If the new technical disclosure involves modifications or alternatives, the abstract should mention by way of example the preferred modification or alternative.

The abstract should not refer to purported merits or speculative applications of the invention and should not compare the invention with the prior art.

Where applicable, the abstract should include the following:

- (1) if a machine or apparatus, its organization and operation;
- (2) if an article, its method of making;
- (3) if a chemical compound, its identity and use;
- (4) if a mixture, its ingredients;
- (5) if a process, the steps.

Extensive mechanical and design details of apparatus should not be given.

1. The abstract of the disclosure is objected to because it fails to concisely state the subject matter of the claimed invention. Correction is required. See MPEP § 608.01(b).

2. The Examiner respectfully suggests amending the abstract as follows:

~~A night light assembly includes a light source, such as an electrical bulb and a cold light panel, and a decoration board removably attached to the light source.~~ The decoration board includes a mount portion having a pair of resilient arms forming a clip for removably attaching the decoration board to the a night light assembly light source at any selected orientation, and a receiving section including a resilient retention tab with a receiving slot defined therebetween to receive and retain a board portion therein. The board portion ~~forms~~ includes decoration patterns, which can be planar, raised or recessed. When the decoration board is attached to the light source by the clip, the board portion is positioned to allow light from the light source to transmit therethrough for projecting the decoration patters to the space in any desired direction.

Claim Objections

3. Claim 1 is objected to because of the following informalities: it recites the limitation "*the mounting portion*" in line 3. There is insufficient antecedent basis for this limitation in the claim.

The cited lack of antecedent instances do not amount to indefinitiveness under 35 U.S.C. 112, second paragraph, since is readily apparent that the claims are referring

back to the previously recited mount portion. However, appropriate correction is required to place the claims in proper form for allowance.

4. The Examiner respectfully suggests amending line 3 of Claim 1, as follows: "end side of the clip, the clip adapted to attach the ~~mounting~~ mount portion to a light".

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

5. Claims 1-3, 6 and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by WISE (U.S. Pat. 2,262,873).
6. WISE discloses a decoration board having:
- **a mount portion (as recited in Claim 1)**, as seen in Figure 2;
 - **a clip (as recited in Claim 1)**, Figure 2, reference number 11;
 - **a receiving section (as recited in Claim 1)**, Figure 2, reference number 9;
 - **the receiving section being mounted to a remote end of the clip (as recited in Claim 1)**, as seen in Figure 2;
 - **the clip being adapted to attach the mount portion to a light source (as recited in Claim 1)**, as evidenced by Figure 4;

- **a board portion (as recited in Claim 1), Figure 2, reference number 5;**
- **the board portion being received and retained in the receiving section (as recited in Claim 1), as seen in Figure 4;**
- **the board portion being positioned in front of the light source when the mount portion is attached to the light source, for allowing light to be transmitted therethrough (as recited in Claim 1), as evidenced by Figure 2;**
- **the clip including two spaced straight arms (as recited in Claim 2), Figure 2, reference number 12;**
- **the two arms forming a substantially U-shape (as recited in Claim 2), as seen in Figure 4;**
- **the clip including two curved arms (as recited in Claim 3), Figure 2, reference number 12;**
- **each arm having a bent end (as recited in Claim 3), as seen in Figure 4;**
- **the board portion having a surface on which decoration patterns are formed (as recited in Claim 6), as seen in Figure 1;**
and
- **the decoration patterns including planar figures, texts and marks (as recited in Claim 7), as seen in Figure 1.**

7. Claims 1-3 and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by SMITH (U.S. Pat. 2,075364).

8. SMITH discloses a decoration board having:

- **a mount portion (as recited in Claim 1), as seen in Figure 6;**
- **a clip (as recited in Claim 1), Figure 5, reference number 198;**
- **a receiving section (as recited in Claim 1), Figure 5, reference number 199;**
- **the receiving section being mounted to a remote end of the clip (as recited in Claim 1), as seen in Figure 6;**
- **the clip being adapted to attach the mount portion to a light source (as recited in Claim 1), as evidenced by column 4, lines 40-47;**
- **a board portion (as recited in Claim 1), Figure 1, reference number 19;**
- **the board portion being received and retained in the receiving section (as recited in Claim 1), column 4, lines 35-40;**
- **the board portion being positioned in front of the light source when the mount portion is attached to the light source, for allowing light to be transmitted therethrough (as recited in Claim 1), as evidenced by Figure 2;**
- **the clip including two spaced straight arms (as recited in Claim 2), as seen in Figure 6;**

- **the two arms forming a substantially U-shape (as recited in Claim 2), as seen in Figure 6;**
- **the clip including two curved arms (as recited in Claim 3), as seen in Figure 6;**
- **each arm having a bent end (as recited in Claim 3), as seen in Figure 6; and**
- **the board portion including a transparent refraction layer formed on a surface thereof (as recited in Claim 9), Figure 1, reference number 19.**

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over WISE (U.S. Pat. 2,262,873).

10. WISE discloses a decoration board having:

- **a mount portion (as recited in Claim 1), as seen in Figure 2;**
- **a clip (as recited in Claim 1), Figure 2, reference number 11;**

- **a receiving section (as recited in Claim 1), Figure 2, reference number 9;**
- **the receiving section being mounted to a remote end of the clip (as recited in Claim 1), as seen in Figure 2;**
- **the clip being adapted to attach the mount portion to a light source (as recited in Claim 1), as evidenced by Figure 4;**
- **a board portion (as recited in Claim 1), Figure 2, reference number 5;**
- **the board portion being received and retained in the receiving section (as recited in Claim 1), as seen in Figure 4;**
- **the board portion being positioned in front of the light source when the mount portion is attached to the light source, for allowing light to be transmitted therethrough (as recited in Claim 1), as evidenced by Figure 2;**
- **the receiving section includes at least one resilient tab (as recited in Claim 4), Figure 2, reference number 8;**
- **the at least one tab being spaced apart from the receiving section to define a slot (as recited in Claim 4), as seen in Figure 3;**
- **the slot receiving an edge of the clip, as seen in Figure 3;**
- **the retention tab including a boss (as recited in Claim 5), Figure 2, reference number 17;**

- **the board including a hole (as recited in Claim 5), Figure 2, reference number 10;**
- **the hole being defined in an edge of the board portion (as recited in Claim 5), as seen in Figure 2;**
- **the boss being engageable with the hole to secure the clip in the slot, as seen in Figure 3.**

11. WISE discloses all the limitations of the claims, except for the slot receiving an edge of the board portion (as recited in Claim 4) and the boss being engageable with the hole to secure the board portion in the slot (as recited in Claim 5).

12. It would have been obvious to one of ordinary skill in the art at the time the invention was made to receive the board portion in the slot with the boss securing such board portion, since it has been held that rearranging parts of a prior art structure involves only routing skill in the art. *In re Japikse*, 181 F.2d 1019, 86 USPQ 70 (CCPA 1950). In this case, locating the slot on the clip for receiving the board portion (as recited in claims 4 and 5), instead of on the board portion to receive the clip (as featured in the patented structure of WISE) would have flown naturally to one of ordinary skill in the art as necessitated by the specific requirements of a particular clip/board portion combination, selection of one arrangement over the other having no critical effect on the claimed subject matter.

13. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over WISE (U.S. Pat. 2,262,873).

14. WISE discloses a decoration board having:

- **a mount portion (as recited in Claim 1), as seen in Figure 2;**
 - **a clip (as recited in Claim 1), Figure 2, reference number 11;**
 - **a receiving section (as recited in Claim 1), Figure 2, reference number 9;**
 - **the receiving section being mounted to a remote end of the clip (as recited in Claim 1), as seen in Figure 2;**
 - **the clip being adapted to attach the mount portion to a light source (as recited in Claim 1), as evidenced by Figure 4;**
 - **a board portion (as recited in Claim 1), Figure 2, reference number 5;**
 - **the board portion being received and retained in the receiving section (as recited in Claim 1), as seen in Figure 4;**
 - **the board portion being positioned in front of the light source when the mount portion is attached to the light source, for allowing light to be transmitted therethrough (as recited in Claim 1), as evidenced by Figure 2;**
 - **the board portion having a surface on which decoration patterns are formed (as recited in Claim 6), as seen in Figure 1;**
- and

- **the decoration patterns including figures, texts and marks (as recited in Claim 8), as seen in Figure 1.**

15. WISE discloses all the limitations of the claims, except the decoration patterns being raised figures, texts and marks (as recited in Claim 8).

16. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use raised figures, texts and marks as the decoration patterns of WISE, since the courts have stated that matters relating to ornamentation only which have no mechanical function cannot be relied upon to patentably distinguish the claimed invention from the prior art. *In re Seid*, 161 F.2d 229, 73 USPQ 431 (CCPA 1947). In this case, using raised decoration patterns would have flown naturally to one of ordinary skill in the art as desired for a particular decorative effect. In addition, it is noted that the specification as filed refers to specific decoration patterns as mere examples of the many decorative patterns that can be used with the claimed invention (see paragraph 17).

Relevant Prior Art

17. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Sibley (U.S. Pat. 217,908), **Gillespie** (U.S. Pat. 1,296,072), **Woolf** (U.S. Pat. 1,706,509) and **Lemmond** (U.S. Pat. 3,194,526) disclose structures having a mount

portion with a pair of resilient arms forming a clip capable of removably attaching the structure to a night light assembly light source.

French et al. (U.S. Pat. 2,583,939), **Curran** (U.S. Pat. 3,443,083), **Sieloff** (U.S. Pat. 3,711,696), **Wu** (U.S. Pat. 4,878,162), **Williams** (U.S. Pat. 5,044,112), **Brady** (U.S. Pat. 5,622,424) and **Hsiao** (U.S. Pat. App. Pub. 2004/0223324) disclose illumination structures including light modifiers having a mount portion with a pair of resilient arms forming a clip for removably attaching the modifier to the illumination structure.

Conclusion

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ismael Negron whose telephone number is (571) 272-2376. The examiner can normally be reached on Monday-Friday from 9:00 A.M. to 6:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sandra L. O'Shea, can be reached on (571) 272-2378. The facsimile machine number for the Art Group is (571) 273-8300.

19. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications maybe obtained from either Private PAIR or Public PAIR. Status

Art Unit: 2875

information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, go to <http://pair-direct.uspto.gov>. Should you have questions on access to Private PAIR system, contact the Electronic Business Center (EBC) toll-free at 866-217-9197.

Sharon Payne
Patent Examiner

Ismael Negron
Examiner
AU 2875